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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/374,577	08/13/1999	FORREST NABORS	34533-51	3935

7590	06/23/2005

ATTEN: GREGORY D. CALDWELL
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EXAMINER
CHOULES, JACK M

ART UNIT	PAPER NUMBER
2167	

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/374,577	NABORS ET AL.
	Examiner	Art Unit	
	Jack M. Choules	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-66 and 69-73* is/are pending in the application.

4a) Of the above claim(s) *1-47* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *48-66 and 69-73* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 April 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-66, and 69-73 are presented for examination. Claims 1-47 being previously

withdrawn from consideration. Claims 67 and 68 having been previously canceled. And claims

71-73 being previously added.

Response to Arguments

1.   Applicant's arguments filed 8 April 2005 have been fully considered but they are not

persuasive.

2.   To the argument against the 35 U.S.C. 101, the applicant argues that the claim 58-66 the

wherein clause includes storing the result of a selection to a memory, which requires

manipulation of a physical device.

3.   In response to the argument against the 35 U.S.C. 101 the examiner respectfully disagrees

the current office position is that "a propagated signal including a carrier wave" is clearly not a

statutory article of manufacture as <u>it is not tangible physical matter or embodied thereon</u>. The

claim preamble recites "A computer data signal embodied in a propagated signal comprising:" as

a signal is not tangible, therefore the signal cannot actually comprise items that are tangible such

as a computer or a memory. Therefor the recital of tangible physical items in the body of the

claim can only set forth a intended use as the structure needed (computer memory etc) cannot be

a part of a signal and therefore cannot be a structure or the claim.

4.   Concerning the rejection under 35 U.S.C. 103(a) of claims 48-66 and 69-73 over

Rothrock and the Draft Proposal, and the rejection under 35 U.S.C. 103(a) of claims 48-66 and

69-73 over Rothrock and Kozol, the applicants argue that Rothrock does not detail "any

hierarchal structure in which standard and [optional] features". The examiner respectfully

disagrees as follows the standard and optional features are seen as non functional data the

hierarchal data structure recites data structure containing non-functional data a that compilations

of data or facts merely stored in the data structure thus being nonfunctional descriptive material,

being directed to data *Per Se* thus the difference is limited to non-functional descriptive material

stored on a machine which cannot render an invention non-obvious for an invention that would

otherwise have been obvious (see MPEP 2106 VI note: MPEP 2106 IV B 1 (b) defines

nonfunctional descriptive material) further displaying or printing or otherwise recalling the data

cannot make functional data that is otherwise non-functional just as playing or printing a song

does not make the song functional descriptive material. It is noted that there is a function for

features of a vehicle which is assumed to be an element of data however since the scope of the

features of a vehicle does not match the scope to any particular data element in the data hierarchy

the data in the hierarchy are treated as non-functional data or descriptive material.

5.   Concerning the rejection under 35 U.S.C. 103(a) of claims 48-66 and 69-73 over

Rothrock and the Draft Proposal, and the rejection of claims 48-66 and 69-73 over the Draft

Proposal, the applicants argue that the Draft Proposal does not detail "maintaining the customer-

centric information in a private or secure, section of the data format". The examiner respectfully

disagrees as follows as to the data hierarchy containing this is defiantly non-functional

descriptive material, and further the private block of data appears to be only a label of a block

being metadata and again in the claimed embodiment non functional descriptive material as the

examiner finds no structure in the claims capable of providing security, and is unable to fide a

clear definition in the specification that defines or shows how a private data block could provide

security with no other structure. Thus the difference is limited to non-functional descriptive

material stored on a machine which cannot render an invention non-obvious for an invention that

would otherwise have been obvious (see MPEP 2106 VI note: MPEP 2106 IV B 1 (b) defines

nonfunctional descriptive material) further displaying or printing or otherwise recalling the data

cannot make functional data that is otherwise non-functional just as playing or printing a song

does not make the song functional descriptive material. It is noted that there is a function for

features of a vehicle which is assumed to be an element of data however since the scope of the

features of a vehicle does not match the scope to any particular data element in the data hierarchy

the data in the hierarchy are treated as non-functional data or descriptive material.

6.   Further arguments were directed to the added wherein clause's for selection of a subset of

sellers that are addressed by the new rejections provided herein below.

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 58-66 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter. The claims are directed "A computer data signal embodied in a

propagated signal including a carrier wave" which is not tangible having no physical

characteristics. A portion of the body of the claim relates to a data structure without so a Data

structure Per se appears to be claimed as it is clearly not claimed as embodied in a computer

readable media or another physical structure. See <u>Warmerdam</u>, 33 F.3d at 1360-1361 (claim to

computer having specific memory held statutory, claim to data structure per se held non-

statutory).

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.   Claims 48-66 and 69-73 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

3.   Claim 48 recites the limitation "the target group of sellers" in line 31. There is

insufficient antecedent basis for this limitation in the claim.

4.   Claim 48 recites the limitation "the RFQ" in line 32. There is insufficient antecedent

basis for this limitation in the claim.

5.   Claim 58 recites the limitation "the target group of sellers" in line 31. There is

insufficient antecedent basis for this limitation in the claim.

6.   Claim 58 recites the limitation "the RFQ" in line 32. There is insufficient antecedent

basis for this limitation in the claim.

7.   Claim 69 recites the limitation "the target group of sellers" in line 28. There is

insufficient antecedent basis for this limitation in the claim.

8.   Claim 69 recites the limitation "the RFQ" in line 29. There is insufficient antecedent

basis for this limitation in the claim.

9.   Further the abbreviation RFQ is not well known in the data structure art and should be

spelled out fully the first time it is used in a chain of claims. For example in claims 48, 58, and

69 rather than in claims 71-73.

Claim Rejections - 35 USC § 103

        The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

1.   **Claims 48-66 and 69-73 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over Rothrock, US Patent Number 5,748,618 in view of Draft Proposal [hereinafter the

Draft] "An Industry Standard Data Format for the Export and Import of Automotive

Customer Leads" and in further view of "PCAgent and CMP Partner to Launch

TechShopper" [Hereinafter **TechShopper**] (Note: the Draft was provided by the applicant in a

IDS provided 13 March 2000 further although the art does not predate CIP priority application

number 09/188,863 the subject mater of the claims is not found in that application).

2.   As to claims 48, 58, 69 and 70-73 the Rothrock disclosed the invention substantially as

claimed including a data processing system ['DP'] comprising a hierarchical data structure (figure

3), "a public block" (figure 3, index 310), "a private block" (figure 3, index 302) and the general

principle of and blocks sub-blocks and categories and data items (figure 3).

10.   The Rothrock not detail delimiters, the specific blocks sub-blocks and categories and data

items claimed, or "to select a subset of the target group of sellers". The Draft describes

delimiters (page 6-14); and the specific blocks sub-blocks and categories and data items claimed

(page 6-14). No attempted has been made to match the actual contents of the blocks, sub-blocks,

categories data elements for example "manufacture, model, model year and style of the vehicle

as this is all non-functional descriptive material and any difference in this rearrangement or non-

functional descriptive material and considered well within the capabilities of one of skill in the

art to implement Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983

(when descriptive material is not functionally related to the substrate, the descriptive material

will not distinguish the invention from the prior art in terms of patentability). TechShopper

details, "to select a subset of the target group of sellers" (first page lines 36-39 Note: Buyers

desired configuration would use features and ranking systems is thought to also rank sellers that

provide the system. Further this is found under the sellerfinder.)

11.   It would have been obvious to one of ordinary skill in the DP art at the time of the

applicant's invention to combine the teachings of the Draft with Rothrock because the system

needs some way of determining where one block or sub-block of data ends and the next begins

so the data can be separately accessed and the delimiters of the Draft provide a straight forward

easily applied method of indicating the end of a block or sub-block of data with the further

advantage that with delimiters the size of a block or sub-block need not be fixed thus saving

space in memory. Further it would have been obvious to one of ordinary skill in the DP art at the

time of the applicant's invention to combine TechShopper with Rothrock and the Draft because

although the Draft states that the data structure it uses is for the use in the automotive retail

industry (the Draft pages 1 and 2) it does not provide a retail system for its use, TechShopper

would provide such a retail system which would be able to use the information from the data

structure of Rothrock combined with Tech Shopper in order provide further utility for the data

processing system.

3.   As to claims 49, 50, 59, and 60, in the Draft delimiters for the sub-blocks etc are

considered to indicate block or sub-block they belong to by positioning (page 6-14) further

linking the delimiters to the hierarchical element they depend on is considered obvious to

maintain the hierarchal structure.

4.   As to claims 51-55 and 61-65 these claims detail non-functional descriptive material and

thus do not distinguish over the prior art (see explanation to rejection of claim 48 hereinabove).

5.   As to claims 56-66, the Draft details XML (page 3).

6.   **Claims 48-66 and 69-73 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over Draft Proposal "An Industry Standard Data Format for the Export and Import of

Automotive Customer Leads" [hereinafter the Draft] and in further view of "PCAgent and

CMP Partner to Launch TechShopper" [Hereinafter TechShopper] (Note: the Draft was provided by the applicant in a IDS provided 13 March 2000 further although the art does not predate CIP priority application number 09/188,863 the subject mater of the claims is not found in that application.)

7.   As to claims 48, 58, 69 and 70-73 the Draft disclosed the invention substantially as claimed including a data processing system ['DP'] comprising delimiters (page 6-14); and the specific blocks sub-blocks and categories and data items claimed (page 6-14). No attempted has been made to match the actual contents of the blocks, sub-blocks, categories data elements for example "manufacture, model, model year and style of the vehicle as this is all non-functional descriptive material and any difference in this rearrangement or non- functional descriptive material and considered well within the capabilities of one of skill in the art to implement Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983 (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

12.   The Draft proposal does not show public and private as claimed or "to select a subset of the target group of sellers". Public and private as used in the claims are merely labels for the blocks having no claimed structure to enforce or act upon the labels the label nor is the term private defined in the specification to include such structure. are also considered nonfunctional descriptive material the difference and the difference is obvious as discussed in MPEP 2106 VI note: MPEP 2106 IV B 1 (b) defines nonfunctional descriptive material). TechShopper details, "to select a subset of the target group of sellers" (first page lines 36-39 Note: Buyers desired

configuration would use features and ranking systems is thought to also rank sellers that provide

the system, further this is found under the sellerfinder).

8.   It would have been obvious to one of ordinary skill in the DP art at the time of the

applicant's invention to combine TechShopper with Rothrock and the Draft because although the

Draft states that the data structure it uses is for the use in the automotive retail industry (the

Draft, pages 1 and 2) it does not provide a retail system for its use, TechShopper would provide

such a retail system which would be able to use the information from the data structure of

Rothrock combined with Tech Shopper in order provide further utility for the data processing

system.

9.   As to claims 49, 50, 59, and 60, in the Draft delimiters for the sub-blocks etc are

considered to indicate block or sub-block they belong to by positioning (page 6-14) further

linking the delimiters to the hierarchical element they depend on is considered obvious to

maintain the hierarchal structure.

10.   As to claims 51-55 and 61-65 these claims detail non-functional descriptive material and

thus do not distinguish over the prior art (see explanation to rejection of claim 48 hereinabove).

11.   As to claims 56-66, the Draft details XML (page 3).

Conclusion

2.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

a.   Dworkin,   US 4992940,   discloses a sales system where user provides item specifications and database finds item and associated vendor based on specification, see abstract.

b.   Lalonde et al   US 5,283,731, discloses a database system storing want adds compares them to attributes within tolerance parameters see abstract and column 6, lines 57-62.

c.   Lynch,   US 5515524,   discloses a configuration system based on customer defined product (e.g. a computer system) components (an attribute) with constraints imposed on each component at least abstract, col. 5 lines 9-22, col. 27 lines 1-67. Lynch also discloses many constraints/alterative are possible on each product component (feature) in a complex product (col.1 1. 32-38) to allow flexibility in the configuration (col. 1 lines 1-65).

d.   Salmon,   US 5592375,   discloses matching products and services, filtering of sellers (buyer inputs location, institutions, schools, i.e. obvious can filter by preferred sellers) user requests for more information are presented with lists of ordered (as to closeness of matching) sellers.

e.   Walker,   US 5794207,   discloses search/ matching of goods and products, in response to an order to system transmits response to buyers, buyer buys through system, third-party, trusted party/ intermediary system, Authenticated seller, verify capacity to deliver (Fig 10). (Provided by applicant but particularly relevant to added material in claims).

f.   Sammon, Jr. et al., US 6012051 teaches flexibility in product configuration

attributes

g.   Green et al   US 6,041,310 A, allows query search for automobile inventory

Green teaches providing customers with a secondary vehicle choice if the desired

configuration cannot be matched exactly from existing inventory (col. 10 line 64 to col.

11 line 8, col. 11 lines 30-37).

h.   Smith et al.,   US 6.052,669 discloses complex product configurations ordering

systems.

i.   Peckover et al, US 61 19101, discloses shopping agents

j.   "Lycos deploys Seven of PersonaLogic's Interactive Decision Guides for an

Enhanced Online Shopping Experience", a method for negotiating over a wide-area

network between a customer and a manufacturer-licensed seller a purchase of a product

having multiple configurations characterized by multiple product attributes (features).

3.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
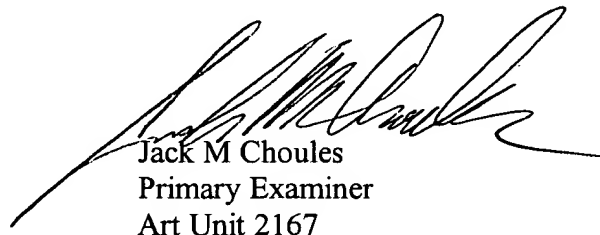
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M. Choules whose telephone number is (571) 272-4109; on 22 October 2004 the phone number will change to (571) 272-4109. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jack M Choules
Primary Examiner
Art Unit 2167

21 February 2004